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In re PATENT APPLICATION of:  
GOLDSTEIN

Confirmation Number: 7433 JAN 31 2005

Group Art Unit: 3627

Application No.: 09/901,094

Filed: July 10, 2001

Examiner: Thein, Maria Teresa T.

Title: SYSTEM AND METHOD FOR PROVIDING CUSTOMERS WITH PRODUCT  
SAMPLESREPLY TO RESTRICTION REQUIREMENTCommissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated November 30, 2004, the period for reply being extended to January 30, 2004 by the enclosed Petition for One-Month Extension of Time, Applicant hereby provisionally elects of the Invention of Group II, claims 14-22 and 35-42. This election is made with traverse.

MPEP §803 states: "There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) There must be serious burden on the examiner if the restriction is required." MPEP §803 also states: "If the search and examination and of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis added.)

MPEP §808 states: "Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections." (Italics emphasis is in original.)

MPEP §808.02 states: "The examiner, in order to establish reasons for insisting upon restriction, must shown by appropriate explanation one of the following: (A) Separate classification thereof; (B) A separate status in the art when they are classifiable together; (c) A different field of search."

It is respectfully submitted that the search and examination of the entire application can be made without a serious burden and the criteria for a proper restriction requirement

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have not been met. Accordingly, it is respectfully submitted that the Restriction Requirement and is improper and must be withdrawn.

Claim 1, which belongs to non-elected Group I, recites a method for providing a user with samples of products during a sample-subscription. The method includes outputting at least one interest category for review by a user; receiving information from the user indicating a selection of at least one interest category; and requesting delivery of products corresponding to the selected at least one interest category to the user during the sample-subscription period. Claim 14, which belongs to elected Group II, recites a method of providing a user with samples of the products during a sample-subscription period. The method includes outputting a plurality of interests for review by a user; receiving information from the user indicating a selection of at least two interests from the plurality of interests; formulating a customized, personal interest category based on the selected at least two interest selected by the user; and requesting delivery of products corresponding to the customized, personal interest category to the user during the sample-subscription period.

It is respectfully submitted that the search and examination for elected claim 14 necessarily encompasses the search and examination for non-elected claim 1. For example, the search and examination for outputting a plurality of interests for review by a user as recited in claim 14 would necessarily encompass the search and examination for outputting at least one interest category for review by a user as recited in non-elected claim 1. As another example, receiving information from the user indicating a selection of at least two interests from the plurality of interests as recited in elected claim 14 would necessarily encompass the search and examination for receiving information from the user indicating a selection of at least one interest category as recited in non-elected claim 1. Accordingly, it is respectfully submitted that the search and examination of the entire application can be made without a serious burden.

It is also respectfully submitted that the Restriction Requirement fails to establish reasons for insisting upon restriction as required by MPEP §§808 and 808.02. For example, the Restriction Requirement on page 2, last paragraph states: "The search required for Group I is not required for Group II." However, as clearly indicated in the Restriction Requirement, both Groups I and II are classified in Class 705, Subclass 26. Accordingly, it is respectfully submitted that the Examiner's determination that the search required for Group I is not required for Group II is incorrect. It is also respectfully submitted that the Restriction Requirement fails to show by appropriate explanation that the inventions of Group I and

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Group II are either (a) separately classified, (b) have attained separate status in the art when they are classified together; or (c) the subject of different fields of search, as required by MPEP §808.02.

It is also respectfully submitted that the Restriction Requirement should be withdrawn in order to prevent duplicative examination by the Patent Office and unnecessary expense to Applicant.

Reconsideration and withdrawal of the Restriction Requirement are respectfully requested.

Respectfully submitted,  
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